

REMARKS

Entry of this Amendment and reconsideration are respectfully requested in view of the amendments made to the claims and the remarks made herein.

Claims 1-15 are pending and stand rejected. Claims 1, 4, 7, 10, 11, 12 and 14 have been amended.

Claims 1,-3, 6, 7, 11, 12, 14 and 15 are rejected under 35 USC 1029b) as being anticipated by Monro (WO 98/37700, cited in the IDS filed 19 June 202).

Applicant respectfully disagrees with, and explicitly traverses, the reason for rejecting the claims. However, in the interest of advancing the prosecution of this matter, applicant has elected to amend the claims to more clearly state the invention. More specifically, claims 1, 7, 10, 11, 12 and 14 have been amended to recite that the maximum row and column values are transmitted in the bit-stream. No new matter has been added. Support for the amendment may be found on page 3, line 1 and page 7, lines 8-11.

Monro, as read by applicant, discloses a method of image compression that includes significance switching of DCT coefficients in block-based embedded DCT processes. Monro further discloses that a mask is transmitted to indicate the determined newly significant bits (see col. 5, lines 40- 46). However, Monro fails to disclose that blocks are scanned for a maximum row number and a maximum column number and these values are transmitted in the bit-steam, as is recited in the claims.

It is well recognized that to constitute a rejection pursuant to 35 USC 102, i.e., anticipation, all material elements recited in a claim must be found in one unit of prior art. For the reason shown above, Monro cannot be said to anticipate the present invention, because Monro fails to disclose each and every element recited in the claim.

Having shown that Monro fails to disclose each and every element recited in the claim, applicant submits that the reason for the rejection of the claim has been overcome and the rejection can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

With regard to independent claims 7, 11, 12 and 14, these claims recite subject matter similar to that recited in claim 1 and each has been amended in a manner similar to

that of claim 1. Each of these claims has been rejected for the same reason used in rejecting claim 1.

In view of the amendment made to claim 7, 11, 12 and 14, which is the same as that made with regard to claim 1, and for the remarks made with regard to the rejection of claim 1, which are reassert, as if in full, herein, in response to the rejection of the above referred-to claims, applicant submits that the reason for rejecting these claims has been overcome and the rejection can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

With regard to claims 2, 3, 6 and 15, these claims ultimately depend from claims 1 and 14, respectively which have been shown to include subject matter not disclosed in, and, hence, are allowable over, the cited reference. Accordingly, claims 2, 3, 6 and 15 are also allowable by virtue of their dependence from allowable base claims. Applicant respectfully request withdrawal of the rejection and allowance of the claim.

Claims 4 and 5 stand rejected under 35 USC 103(a) as being unpatentable over Monro in combination with Yamamitsu.

Applicant respectfully disagrees with, and explicitly traverses, the reason for rejecting the claims.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

As argued above, Monro discloses a method of image compression that scans each element in a plurality of bit planes and fails to teach transmitting the coordinates of a region within each bit plane that includes newly significant information.

Yamanitsu discloses a system that transmits quantized non-zero DCT values within a region and defines the region by a point. However, Yamanitsu fails to teach determining the scanned region to determine newly-significant values. Rather

Yamanitsu merely defines a region as being an area including non-zero DCT coefficients, without regard to whether the DCT coefficients are considered newly significant.

Accordingly, neither Monro nor Yamanitsu, individually or in combination, teach or suggest all the elements recited in the above referred-to claim 4.

Having shown that the combination of Monro and Yamanitsu fails to teach or suggest all the elements recited in claim 4, applicant submits that the reason for the examiner's rejection has been overcome and the rejection can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

With regard to claim 5, this claim depends from claim 4, which has been shown to not be obvious, and allowable, in view of the cited references. Accordingly, claim 5 is also allowable based on its dependence from an allowable claim. Applicant respectfully request reconsideration, withdrawal of the rejection and allowance of the claim.

Claims 8 and 13 stands rejected under 35 USC 103(a) as being unpatentable over Monro in combination with Jiankun Li.

Applicant respectfully disagrees with, and explicitly traverses, the reason for rejecting the claims. With regard to claim 8, this claim depends from claim 7, which has been shown to be allowable over Monro as Monro fails to disclose a material element claimed (transmitting the coordinates of a region within each bit plane that includes newly significant information). Li is also silent with regard to transmitting the coordinates of a region within each bit plane that indicates newly significant information.

Hence, the combination of Monro and Li fails to render obvious the present invention as recited in claim 8, as the combined device fails to disclose all the elements claims.

With regard to claim 13, this claim depends from claim 12, which has been shown to be allowable over Monro as Monro fails to disclose a material element claimed (transmitting the coordinates of a region within each bit plane that includes newly significant information). Li is also silent with regard to transmitting the coordinates of a region within each bit plane that indicates newly significant information.

Hence, the combination of Monro and Li fails to render obvious the present invention as recited in claim 13, as the combined device fails to disclose all the elements claimed.

For the above remarks, applicant respectfully requests withdrawal of the rejection and allowance of the claims.

Claim 9 stands rejected under 35 USC 103(a) as being unpatentable over Monro in combination with Kleihorst (Implementation of DCT-Domain Motion Estimation and Compensation).

Applicant respectfully disagrees with, and explicitly traverses, the reason for rejecting the claims. With regard to claim 9, this claim depends from claim 7, which has been shown to be allowable over Monro as Monro fails to disclose a material element claimed (transmitting the coordinates of a region within each bit plane that includes newly significant information). Kleihorst is also silent with regard to transmitting the coordinates of a region within each bit plane that indicates newly significant information.

Hence, the combination of Monro and Kleihorst fails to render obvious the present invention as recited in claim 8, as the combined device fails to disclose all the elements claimed. For at least this reason, applicant submits that the reason for the rejection has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection.

Claim 10 is rejected under 35 USC 103(a) as being unpatentable over Monro and Jiankun Li in further combination with Fujikawa (USP no. 4,972,260).

As argued above, the combination of Monro and Li fails to teach a material element claimed. Fujikawa is also silent with regard to transmitting the coordinates of a region within each bit plane that includes newly significant information.

Hence, the combination of Monro, Li and Fujikawa Kleihorst fails to render obvious the present invention as recited in claim 10, as the combined device fails to disclose all the elements claimed.

For at least this reason, applicant submits that the reason for the rejection has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection.

Claim 10 stands rejected under 35 USC 103(a) as being unpatentable over Monro and Kleihorst in further combination with Fujikawa.

As argued above, the combination of Monro and Kleihorst fails to teach a material element claimed. Fujikawa is also silent with regard to transmitting the coordinates of a region within each bit plane that includes newly significant information.

Hence, the combination of Monro, Kleihorst and Fujikawa fails to render obvious the present invention as recited in claim 10, as the combined device fails to disclose all the elements claimed.

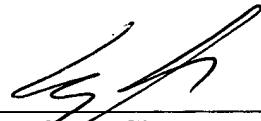
For at least this reason, applicant submits that the reason for the rejection has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection.

Although the last Office Action was made final, this amendment should be entered. The claims have each been amended to more clearly state the invention. Since no matter has been added to the claims that would require comparison with the prior art or any further review only require a cursory review is required by the examiner. The amendment therefore should be entered without requiring a showing under 37 CFR 1.116(b).

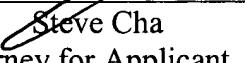
For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Russell Gross
Registration No. 40,007



Date: February 22, 2005

By: 
Steve Cha
Attorney for Applicant
Registration No. 44,069

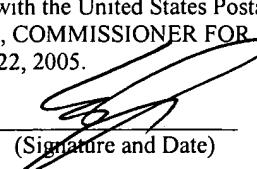
Mail all correspondence to:

Russell Gross, Registration No. 40,007
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9624
Fax: (914) 332-0615

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Steve Cha, Reg. No. 44,069
(Name of Registered Rep.)


(Signature and Date)